

REMARKS

Claims 258-261 and 267-270 are presently pending in the patent application.

I. OBJECTION TO THE SPECIFICATION/ CLAIM REJECTION – 35 U.S.C. § 112, 1ST PARAGRAPH

The Examiner objected to the amendment filed October 30, 2007, as introducing new matter into the disclosure. Specifically, the Examiner alleged that the subject matter lacking support consisted of “details about a bulk coin receptacle as well as the acceptance of bulk coins”. The Examiner continued on to state that “[t]hese details are not disclosed in the original specification or the original claims”. This objection is traversed.

The Examiner also rejected claims 258-261 and 267-270 under 35 U.S.C. § 112, 1st paragraph, as failing to comply with the written description requirement. This rejection is traversed.

The Examiner alleged that the claims “contains subject matter which was not reasonably described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention” in that “[t]he applicant includes details about a bulk coin receptacle as well as the acceptance of bulk coins”. (*see* Final Office Action, page 3). The Examiner continued on to state that “[t]here are details of mixed loose coins that are added but there is nothing in the original disclosure that shows or teaches that the coins aren’t added one at a time. (¶ 397).”

Matter not in the original specification, claims, or drawings is usually new matter. As stated in *TurboCare Div. of Demag Delaval Turbomachinery Corp. v. General Elec. Co.*, 264 F.3d 1111, 1118 (Fed. Cir. 2001):

The written description requirement and its corollary, the new matter prohibition of 35 U.S.C. § 132, both serve to ensure that the patent applicant was in full possession of the claimed subject matter on the application filing date. When the applicant adds a claim or otherwise amends his specification after the original filing date . . . , the new claims or other added material must find support in the original specification.

The test for determining whether a specification is sufficient to support a particular claim “is whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’” *Ralston Purina Co.*

v. Far-Mar-Co, Inc., 772 F.2d 1570, 1575 (Fed.Cir.1985) (*quoting In re Kaslow*, 707 F.2d 1366, 1375 (Fed.Cir.1983)). Thus, “[i]t is not necessary that the application describe the claim limitations exactly, but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations.” *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976) (citation omitted). Conversely, in determining whether subject matter presented in an amended claim constitutes an introduction of “new matter” into the disclosure also relates to whether “persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations” and the issue at hand is whether the application as filed reasonably conveys to one of ordinary skill that Applicants were in possession of the subject matter recited in the claim. *See Ralston Purina and Wertheim, supra*.

Paragraph [0397] states that “[a] coin transaction is described in greater detail in FIG. 56f” wherein, “[a]s shown, a customer loads mixed coins into the system at step 12a” and “[t]he coins are sorted, authenticated, and bagged one at a time.”

Paragraph [0416] states that “the system may include a coin sorting and discrimination module 19” and that “FIGS. 58-61 illustrate a disc-type coin sorter used in coin sorting and discrimination module 19 that uses a coin-driving member having a resilient surface for moving coins along a metal coin-guiding surface of a stationary coin-guiding member.” Paragraph [0416] goes on to note, and incorporate by reference, coin sorters including, but not limited to, rail sorters (disclosed in U.S. Pat. Nos. 5,163,868 and 5,114,381, each incorporated by reference in its entirety), a core sorter (disclosed in U.S. Pat. No. 2,835,260, incorporated by reference in its entirety), a sifter-type sorter (disclosed in U.S. Pat. No. 4,360,034, incorporated by reference in its entirety), or coin-counting disks (described in U.S. Pat. No. 4,543,969, incorporated by reference in its entirety), a drum sorter, or a dual-disc sorter, as well as the sorters described, for example, in U.S. Pat. Nos. 2,750,949 and 5,299,977, each of which was incorporated by reference in its entirety. One of ordinary skill in the art would consider such teaching in assessing whether or the application, as filed, reasonably conveyed that Applicants were in possession of the subject matter now recited in the claims. U.S. Pat. No. 4,543,969, which is assigned to the present assignee, discloses, for example, that “[s]ome businesses, particularly banks, are often faced with a large amount of coin currency at the end of a business day, week or month which must be organized, counted and recorded” and that “[t]o make counting of coins

less laborious, machines have been developed which automatically sort by denomination a mixed group of coins” (col. 1, lines 14-23)(see Fig. 1). In U.S. Pat. No. 4,543,969, “[a] collection of mixed denomination coins are dropped onto the surface of the rotating disk through a central opening in the stationary disk whereby the rotating disk imparts a rotational movement to the coins” (col. 1, lines 59-63) and that “[t]o start the sorting process a collection of mixed denomination coins 11 is dropped onto a staging platform 13 which is an integral part of a housing cover 15.” (col. 3, lines 50-53).

Further, similar to Applicant’s U.S. Pat. No. 4,543,969, Applicant’s specification discloses that “the coin-driving member is a rotating disc, and the coin-guiding member is a stationary sorting head” and that “[a]s can be seen in FIG. 58, a hopper 1510 receives coins of mixed denominations and feeds them through central openings in a housing 1511 and a coin-guiding member in the form of an annular sorting head or guide plate 1512 inside or underneath the housing” wherein, “[a]s the coins pass through these openings, they are deposited on the top surface of a coin-driving member in the form of a rotatable disc 1513.” (see par. [0416])(see also The AMERICAN HERITAGE DICTIONARY, SECOND COLLEGE EDITION, which defines “hopper” as “. . . 2. a. A funnel-shaped container in which materials such as grain or fuel are stored in readiness for dispensation. b. Any of various other receptacles in which something is held in readiness prior to usage or consideration”). The use of a “hopper” to feed coins would be understood by one of ordinary skill in the art to mean a receptacle that has a larger area on the top and a smaller area on the bottom intended to accept a large quantity of coins and to, while “storing” at least some of the coins, moderating a flowrate of the coins through the bottom of the hopper onto the rotatable disc. Par. [0397] likewise discloses a coin transaction in which “a customer *loads* mixed coins into the system at step 12a” (emphasis added) whereupon the coins are “sorted,” as disclosed. “Loads” again conventionally would be interpreted, in context with the disclosure, as describing the inputting of an appreciable number of coins (see, e.g., The AMERICAN HERITAGE DICTIONARY, SECOND COLLEGE EDITION, which defines “load” as, for example, “To provide or fill nearly to overflowing”). In this regard, it is noted that FIG. 59 shows 38 coins being simultaneously guided by the sorting head 1512.

The specification discloses in great detail in paragraphs [0416]-[0462] how the input coins are sorted and/or discriminated (see, e.g., par. [0460]) and counted. The entire structure of the disclosed machine is clearly configured for rapid sorting of bulk coins, from the use of a

hopper 1510 (see par. 0416); FIG. 58) to control the injection of the bulk coins into the upper end of the hopper (see definition from the AMERICAN HERITAGE DICTIONARY, SECOND COLLEGE EDITION, *supra*), the use of a motor driven disc to impart a sufficient rotational velocity so that “the coins 1525 deposited on the top surface thereof tend to slide outwardly over the surface of the pad due to centrifugal force” (par. [0418]), the disclosure that the sorting operation is “*high speed*” (par. [0419])(emphasis added), the disclosure that the sorting head 1512 includes “various channels and other means especially designed for *high-speed sorting* with positive control of the coins” (par. [0420])(emphasis added). This structure is designed for speed and bulk coin processing, as would be immediately recognized by one of ordinary skill in the art. As noted above, FIG. 59 shows 38 coins being simultaneously guided at high-speed by the sorting head 1512. In contrast, the MC5 Coin Changer noted by the Examiner, accepts inputs of only one coin at a time.

The written description requirement of § 112 requires the application to “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991); *see also In re Wright*, 866 F.2d 422, 424 (Fed. Cir. 1989) (“When the scope of a claim has been changed by amendment in such a way as to justify an assertion that it is directed to a different invention than was the original claim, it is proper to inquire whether the newly claimed subject matter was described in the patent application when filed as the invention of the applicant. That is the essence of the so-called ‘description requirement’ of § 112, first paragraph”). However, the claimed subject matter need not be described “*in haec verba*” in the original specification in order to satisfy the written description requirement. *In re Wright*, 866 F.2d at 425. Rather, “the test . . . is whether a person of ordinary skill in the art would recognize that the applicant possessed what is claimed in the later filed application as of the filing date of the earlier filed application.” *Noelle v. Lederman*, 355 F.3d 1343, 1348 (Fed. Cir. 2004). The same standards govern whether new matter has been added to the specification. *See TurboCare*, 264 F.3d at 1118.

Applicants submit that, for at least the above reason, no new matter has been added and requests withdrawal of both the above-noted objection and the 35 U.S.C. § 112, 1st paragraph, written description rejection.

Applicants further submit that, by virtue of at least the assignee's own U.S. Pat. No. 4,543,969, in which "[a] collection of mixed denomination coins are dropped onto the surface of the rotating disk through a central opening in the stationary disk whereby the rotating disk imparts a rotational movement to the coins" (col. 1, lines 59-63) and that "[t]o start the sorting process a collection of mixed denomination coins 11 is dropped onto a staging platform 13 which is an integral part of a housing cover 15." (col. 3, lines 50-53). U.S. Pat. No. 4,543,969, also discloses that "[t]he coins 11 are manually pushed along the gentle sloping incline of the staging platform 13 and fall into a hopper 17 as indicated by the arrows in FIG. 1" whereupon "[t]he coins are directed by the hopper 17 into the coin sorter apparatus which is comprised of a rotating disk 19 and a stationary disk 21, shown in cross-section in FIG. 1" (*see, e.g.*, col. 3, lines 45-62). The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. *See, e.g.*, MPEP § 2163.07(b), "Incorporation by Reference [R-3]". Applicants submit that, for at least this reason, no new matter has been added and requests withdrawal of both the above-noted objection and the 35 U.S.C. § 112, 1st paragraph, written description rejection.

II. CLAIM REJECTION – 35 U.S.C. § 112, 2ND PARAGRAPH

The Examiner rejected claims 258-261 and 267-270 under 35 U.S.C. § 112, 2nd paragraph, as being indefinite. This rejection is traversed.

The Examiner alleged that, as to claims 258 and 267, the word "singulating" renders the claims indefinite because the claims include a word "that is not defined by the applicant nor is it a word found in an English dictionary thereby rendering the scope of the claim(s) unascertainable". (*see* Final Office Action, page 3).

A search of the USPTO database (published patents) using the term "singulating" provided **1850** (one thousand, eight hundred and fifty) results. A narrower search of the combination of the term "singulating" and "coin" in the USPTO database (published patents) revealed **27** patents. A similar search of the USPTO database (published patent applications) using the term "singulating" provided **1737** published patent applications (one thousand, seven hundred and thirty seven). A narrower search of the combination of the term "singulating" and "coin" in the USPTO database (published patent applications) revealed **14** published patent applications. Obviously, this term is not unknown to the English language, nor is the usage of

this term repugnant to such usage (*See In re Hill*, 161 F.2d 367 (CCPA 1947)(The Applicant is entitled to be his own lexicographer). The term singulation is not only used in Applicant's art, but in other arts to refer to the orderly processing of a multitude of substantially simultaneously presented objects. As disclosed by Applicants, means are provided, for example, to reference the coins to obtain "a single-file stream of coins directed against the outer wall 1562" and means to "align the outermost edge of the coins with a gaging wall 1577". The coins are thus singulated as described in more detail in, for example, paragraphs [0420]-[0430].

Definiteness of claim language must be analyzed in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one of ordinary skill in the art at the time the invention was made. *See, e.g., In re Moore*, 439 F.2d 1232, 1235; 169 USPQ 236, 238 (CCPA 1971). The essential inquiry is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity. Whether more suitable language or modes of expression are available is not the requisite test.

Applicants request reconsideration and withdrawal of this rejection.

III. CLAIM REJECTION - 35 U.S.C. § 103

Claims 258-261 and 267-270 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. (US 5,641,050)("Smith") in view of Avnet et al. US 5,291,003 ("Avnet"). Reconsideration and withdrawal of this rejection is respectfully requested.

Smith is alleged to disclose redeeming currency from a customer at a self-service machine (col. 5, line 30 – col. 17, line 3). Smith is alleged to disclose "receiving money input by the customer the act of receiving money input by the customer comprising substantially simultaneously receiving, in a coin receptacle, randomly oriented coins input by the customer (col. 7, lines 43-67, col. 10, lines 20-45)" and "a coin separation device (col. 5, line 30 – col. 10, line 55)" (*see* Final Office Action, page 5). The Examiner further alleges that "[t]he coin separation device is incorporated by Smith's reference to the MC5 coin changer manual" and that "Smith teaches discriminating between authentic and non-authentic forms of the money including discriminating between valid coins and invalid coins of the bulk coins (col. 7, lines 43-67, col. 10, lines 20-45)" (*see* Final Office Action, page 4).

The Examiner continues on to allege that "Smith teaches determining a total value of the authentic forms of the money input by the customer (at least col. 7, lines 43-67, col. 10, lines 20-

45)” and that “Smith teaches dispensing various items, including technological devices, and never limits what the machine can dispense (abstract, col. 6, lines 42-col. 20, line 13)” (*see* Final Office Action, page 4)

The Examiner acknowledges that Smith “does not specifically state that a card can be dispensed by the invention and since Smith does not teach away it is possible that Smith could dispense a card.” (*see* Final Office Action, sentence bridging pages 4-5). To make up for this deficiency, the Examiner cites Avnet as allegedly disclosing “dispensing a card having a storage medium for storing a monetary value that is related to the total inputted value (col. 1, line 60 – col. 5, line 40)” (*see* Final Office Action, page 5).

The Examiner concludes and alleges “[i]t would therefore be obvious to one of ordinary skill in the art at the time of invention to modify Smith to include the details of dispensing a card,” stating that “[b]oth Avnet and Smith teach vending machines” and that “since Smith teaches that there are multiple items that can be dispensed by the machine it would have been obvious for Smith to dispense a value card” (*see* Final Office Action, page 5). The Examiner further states that “[t]he purpose in combining the two references is to teach that vending machines that dispensed cards with values did exist at the time of the invention, and to show Smith could have dispensed cards with values” (*see* Final Office Action, page 5).

Smith does not disclose or suggest, as alleged, “a coin separation device (col. 5, line 30 – col. 10, line 55)” (*see* Final Office Action, page 5). The customer of the vending machine himself or herself separates the coins and places them, one at a time, in slot 35. The vending machine itself performs no “separation” of coins or sorting, nor has the MC5 line of coin changers been shown, explicitly or inherently, to disclose or suggest separation of coins, as alleged (e.g., as opposed to, for example, simply validating and summing the coins individually placed into the slot).

Smith also fails to disclose or suggest dispensing items “including technological devices,” as alleged. The Examiner has not shown that Smith even discloses a single example of such a technological device. Instead, the Examiner casts the inquiry in the negative and attempts to show not what Smith teaches, but what it teaches by the virtue of not explicitly inclusion (i.e., the Examiner is alleging that Smith “never limits what the machine can dispense”). By the Examiner’s logic, every reference could be cited not for what it discloses and suggests, but for what it does not expressly exclude. This position does not comport with the case law concerning

35 U.S.C. § 103 and contrary to the Examiner's unsupported conclusion, Smith does not constitute a domain of infinite scope. The Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. *See, e.g., In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The legal concept of *prima facie* obviousness is a procedural tool of patent examination, allocating the burdens of going forward with production of evidence in each step of the examination process (*citations omitted*)(*see, e.g.,* MPEP § 2142). *See also Ex parte Smith*, 83 USPQ2d 1509, 1515 (Bd. Pat. App. & Int. 2007)(*citing In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

Applicants submit that the Examiner's burden to set forth a *prima facie* case of obviousness has not been discharged, as broad conclusory statements, standing alone, are not "evidence" supportive of a *prima facie* showing. *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578 (Fed. Cir. 1993).

Both Smith and Avnet similarly fail to disclose or suggest an "act of receiving money input by said customer comprising substantially simultaneously receiving, in a bulk coin receptacle, randomly oriented bulk coins input by said customer" (claim 258). Avnet discloses on col. 2, line 3, that "coins" are accepted, Avnet discloses and suggests nothing more than a conventional vending machine apparatus comprising a coin slot that is not configured to permit substantially simultaneously receiving, in a bulk coin receptacle, randomly oriented bulk coins input by a customer. Likewise, both Smith and Avnet fail to disclose or suggest, for example, an act of "singulating the bulk coins using a coin separation device." Similar to claim 258, discussed above, Applicants respectfully submit that Smith and Avnet fail to disclose or suggest, singly or in combination, at least the acts of "receiving bulk coins input by said customer, said act of receiving bulk coins comprising substantially simultaneously receiving, in a bulk coin receptacle, randomly oriented bulk coins input by said customer" or "singulating the bulk coins using a coin separation device" (claims 268-270).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). Applicants respectfully submit that Smith and Avnet fail to disclose or suggest, singly or in

combination, all of the claim limitations of independent independent claims 258 and 268, or of claims depending therefrom.

IV. Conclusion

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the number indicated.

The Applicants submit that the claims are in a condition for allowance and action toward that end is earnestly solicited.

It is believed that, beyond the fee for the one-month extension of time, no additional fees are due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247171-000373USD1.

Respectfully submitted,

April 30, 2008
Date

/William D. PEGG, Reg. No. 42,988/
William D. Pegg
Reg. No. 42,988
Nixon Peabody LLP
161 North Clark Street, 48th Floor
Chicago, IL 60601-3213
(312) 425-3900 – Telephone
(312) 425-3909 – Facsimile

Attorneys for Applicants